

REMARKS

Pursuant to the present amendment, claims 1, 7, 10, 15, 21 and 24 have been amended. Claims 1-3, 6, 7, 9-16, 18, 19, 21, 22 and 24-28 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

In the Office Action, claims 1-3, 6, 7, 10-13, 15, 16, 18, 19, 21, 22 and 24-27 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by O’Neil (U.S. Patent No. 6,306,172). Claims 1, 2, 3, 6, 7, 10-12, 15, 16, 18, 19, 21, 22 and 24-26 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Bloebaum (U.S. Patent No. 4,883,488). Claims 14 and 28 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over O’Neil in view of Smith (U.S. Patent No. 5,108,442). Claims 13 and 27 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Bloebaum in view of O’Neil. Claims 14 and 28 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Bloebaum in view of Smith. Applicants respectfully traverse the Examiner’s rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v.*

Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Health-*

care Corp., 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

It appears to the undersigned that the Examiner's rejections set forth in the Final Office Action are based upon the overly broad interpretation (Final Office Action, p. 2) of "perimeter side surfaces" set forth in the previously pending claims. Respectfully, it appears as though the Examiner ignored the express reference to the perimeter side surfaces of the base plate and the insert. Nevertheless, independent claims 1 and 15 have been amended to more specifically identify the "outer perimeter side surfaces" of the base plate and insert and more specifically describe the precise location of the "outer perimeter side surfaces" of the base plate and insert relative to other structure of the base plate and insert, e.g., the upper and lower surfaces of the base plate and insert. No new matter has been introduced by way of the present amendment as the upper and lower surfaces and the outer perimeter side surfaces of the base plate and insert are clearly disclosed in the application. For example, see Figures 1-4, 6-8 and 10A-10D and the associated discussion in the specification, e.g., page 10, lines 8-17. As thus amended, it is respectfully submitted that all pending claims are in condition for immediate allowance.

It is respectfully submitted that the structure defined by the pending claims is not disclosed nor remotely suggested by O'Neil. As understood by the undersigned, in all

embodiments disclosed therein, the pin or structure used to prevent rotation of the insert relative to the base plate is positioned, in one form or another, in openings formed in the bottom surface of the insert and the top surface of the base plate. At no point does O’Neil suggest or disclose the location of a removable pin or removable means that engages openings formed in the outer perimeter side surfaces of the insert and the base plate as now set forth in the pending claims. Thus, all claims are believed to be in condition for immediate allowance.

Bloebaum also does not disclose or suggest the invention defined by the pending claims. As understood by the undersigned, the base plate and insert do not have openings in the outer perimeter side surfaces of the base plate and insert disclosed therein. Moreover, the pins 62, 64 are not adapted to be positioned in openings formed in the outer perimeter side surfaces of the base plate and insert as recited in the pending claims.

As to the use of the phrase “adapted to,” the use of “adapted to” language was specifically approved by the Board of Patent Appeals and Interferences in an appeal taken in the application that resulted in U.S. Patent No. 6,666,754. In the appeal of that case, the Board of Patent Appeals and Interferences did not sustain the Examiner’s rejection under 35 U.S.C. § 112 for the use of the terminology “adapted to” in the claims at issue in that case. Decision on Appeal dated April 25, 2003.¹ More specifically, in that case, the Examiner’s rationale for the Section 112 rejection was as follows:

“The use of the terminology ‘adapted to’ makes the claim vague and indefinite because the scope of the claims cannot be ascertained, since it has been held the recitation that an element is ‘adapted to’ perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 U.S.P.Q. 138.

¹ It is assumed that the Examiner can obtain a copy of the decision by the Board of Appeals. If that is not the case, please notify the undersigned and a copy of that decision will be submitted.

Decision on Appeal, p. 4. In reversing the Examiner's claim rejections under 35 U.S.C. § 112, the Board noted:

"The use of the terminology 'adapted to' in claim 21 does not render claims 21-32 vague and indefinite since the scope of the claim can be ascertained. As set forth by the Examiner, the recitation that an element is 'adapted to' perform a function is a limitation which requires only that the structure be able to perform the function. As such, the scope of the claims can be ascertained with a reasonable degree of precision and predictability.

Decision on Appeal, pp. 4-5. The use of "adapted to" language is also supported by the statements of the Board of Patent Appeals and Interferences in *Ex Parte Robert-A. Ollar*, 1994 WL 1687107, Bd. Pat .App & Interf., 1994, which states:

"On the other hand, we are aware of support for a holding that 'adapted to' and 'whereby' clauses in claims further limit the claimed subject matter and should not be disregarded. For example, see *In re Venezia*, 530 F.2d 956, 958-59, 189 U.S.P.Q. 149, 151-52 (CCPA 1976). *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 U.S.P.Q.2d 1871, 1876 (Fed. Cir. 1990) recognizes (emphasis added) that: ... by deleting the preamble and all limitations that include 'adapted to,' 'whereby,' and 'thereby' ... the claims are reduced to mere collections of parts."

In view of the foregoing, it is respectfully submitted that the use of the "adapted to" language in the present case is proper. The scope of the claims containing the limitation is readily understandable. Thus, the limitation associated with such language must be considered a positively recited limitation. With this understanding, it is respectfully submitted that all pending claims are allowable.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is respectfully submitted that any attempt to assert that the invention defined by amended

independent claims 1 and 15 would have been obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicants' disclosure as a roadmap. "Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Teleflex v. KSR Intern. Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005) (unpublished) (citations omitted).

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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